

**REMARKS**

Claims 1-61, 64-66, 68-77, 79-84, and 86-120 were pending in the application.

Claims 34-61 and 99-120 were allowed.

Claims 1-12, 14-20, 26, 27, 65, 68, 73, 74, 76, 79, 83, 86 and 89-98 were rejected.

Claims 13, 21-25, 28-33, 64, 66, 69-72, 75, 77, 80-82, 84, 87 and 88 were objected to.

Claims 7, 8, 13, 21-25, 27, 28, 29, 31, 64, 66, 69-72, 75, 77, 80-82, 84, 87, 88, 89, 91, 97, 106, and 107 have been amended.

Claims 121-131 have been added.

Reconsideration and allowance of claims 1-61, 64-66, 68-77, 79-84, and 86-131 is respectfully requested in view of the following.

**The Rejection of Claims 1-3, 65, 68, 73, 74, 76, 79, 83, and 86 in view of Abdrakhmanov:**

Claims 1-3, 65, 68, 73, 74, 76, 79, 83, and 86 were rejected under 35 U.S.C. 102(b) as being anticipated by Abdrakhmanov (U.S. 5,083,608). The Applicant respectfully disagrees.

Abdrakhmanov discloses an arrangement for patching off troublesome zones in a well that includes profile pipes (1) which are radially expanded by pressurizing the interiors of the profile pipes with a fluid and then using an expander (20'). Each of the profile pipes (1) include cylindrical end portions (2) coupled together by intermediate non-cylindrical portions. Abdrakhmanov is completely silent as to the relative burst strengths of the portions of the profile pipes (1).

Claims 1-3 all require that "the burst strength of the first and second tubular sections is substantially equal to the burst strength of the intermediate tubular section." By contrast, Abdrakhmanov does not disclose or suggest the relative burst strengths of the portions of the profile pipes (1). In the office action dated 3/17/2005, on page 11, the Examiner admits that Abdrakhmanov does not explicitly disclose or suggest the

relative burst strengths of the portions of the profile pipes (1). The Examiner then asserts that the cylindrical portion of the profile pipe (1) of Abdrakhmanov will inherently have substantially the same burst strength as the non-cylindrical portions of the profile pipe (1). This assertion is simply without any factual basis in Abdrakhmanov.

"[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination." *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 814 (1989). Furthermore, it is axiomatic that a prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. U.S. Int'l Trade Comm'n.*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). Thus, the Examiner's rejection can only be valid if Abdrakhmanov both suggests and enables the claimed limitation. Abdrakhmanov fails on both counts.

For example, as described in the specification of the present application with reference to Figs. 48, 49, 50a to 50e, an exemplary embodiment of the invention of claim 1-3, the process for manufacturing an expandable tubular member having: a first tubular section having a first outer diameter comprising a first threaded connection; an intermediate tubular section coupled to the first tubular section having an intermediate outer diameter; and a second tubular section having a second outer diameter coupled to the intermediate tubular section having a second outer diameter comprising a second threaded connection; wherein the first and second outer diameters are greater than the intermediate outer diameter; and wherein the burst strength of the first and second tubular sections is substantially equal to the burst strength of the intermediate tubular section involves a number of processing steps to provide the substantially uniform burst strength throughout the expandable tubular member. In other words, something affirmative must be done to provide the substantially uniform burst strength throughout the expandable tubular member, uniform burst strength is not an inherent property of a tubular member having radially expanded end portions.

By contrast, Abdrakhmanov provides absolutely no suggestion of any processing of the profile pipes (1) to achieve a substantially uniform burst strength throughout. Thus, Abdrakhmanov fails to suggest and fails to enable the claimed limitation.

Therefore, there is no factual basis for the rejection of claims 1-3, and the rejection of claims 1-3 should be withdrawn. See MPEP § 2131.

Thus, Abdrakhmanov does not disclose or suggest the invention of claim 1. Furthermore, for at least the same reasons, Abdrakhmanov also does not disclose or suggest the invention of claims 65 and 68 that depend from claim 1.

In addition, claim 65, among other things, requires that the angles of inclination of the first and second tubular transitional members relative to the intermediate tubular section ranges from about 0 to 30 degrees. Abdrakhmanov is completely silent as to the angle of inclination of the tapered portions of the profile pipes (1). Thus, for at least these additional reasons, Abdrakhmanov does not disclose or suggest the invention of claim 65.

Thus, Abdrakhmanov also does not disclose or suggest the invention of claim 2. Furthermore, for at least the same reasons, Abdrakhmanov also does not disclose or suggest the invention of claims 73, 74, 76, and 79 that depend from claim 2.

In addition, claim 73, among other things "... applying a protective coating onto the radially expanded first and second ends of the tubular member." By contrast, the only part of the profile pipes (1) of Abdrakhmanov that include an outer coating is a lower profile pipe that includes an outer sealing element 7 that is positioned *between* radially expanded end portions. Thus, for at least these additional reasons, Abdrakhmanov does not disclose or suggest the invention of claim 73.

In addition, claim 76, among other things, requires that the angles of inclination of the first and second tubular transitional members relative to the intermediate tubular section ranges from about 0 to 30 degrees. Abdrakhmanov is completely silent as to the angle of inclination of the tapered portions of the profile pipes (1). Thus, for at least these additional reasons, Abdrakhmanov does not disclose or suggest the invention of claim 76.

Thus, Abdrakhmanov also does not disclose or suggest the invention of claim 3. Furthermore, for at least the same reasons, Abdrakhmanov also does not disclose or suggest the invention of claims 83 and 86 that depend from claim 3.

In addition, claim 83, among other things, requires that the angles of inclination of the first and second tubular transitional members relative to the intermediate tubular

section ranges from about 0 to 30 degrees. Abdrakhmanov is completely silent as to the angle of inclination of the tapered portions of the profile pipes (1). Thus, for at least these additional reasons, Abdrakhmanov does not disclose or suggest the invention of claim 83.

**The Rejection of Claims 4-6, 93 and 94 in view of Simpson:**

Claims 4-6, 93 and 94 were rejected under 35 U.S.C. 102(b) as being anticipated by Simpson (WO 00/3776). The Applicant respectfully disagrees.

**Simpson is not Prior Art to the Present Application:**

The Simpson reference is a printed PCT publication having a date of publication of June 29, 2000. Thus, for purposes of 35 U.S.C. 102, the prior art date of Simpson is June 29, 2000.

The present application is the U.S. National Stage application for PCT application serial number PCT/US00/18635, filed on July 7, 2000, which claimed the benefit of the filing date of U.S. provisional patent application serial number 60/143,039, filed on July 7, 1999, and U.S. provisional patent application serial number 60/146,203, filed on July 29, 1999.

The present application is also a continuation-in-part of U.S. patent application serial number 09/588,946, attorney docket number 25791.17.02, filed on 6/7/2000, which claimed the benefit of U.S. provisional patent application serial number 60/137,998, filed on 6/7/1999, which was a continuation-in-part of U.S. patent application serial number 09/559,122, attorney docket number 25791.23.02, filed on 4/26/2000, which claimed the benefit of U.S. provisional patent application serial number 60/131,106, filed on 4/26/1999, which was a continuation-in-part of U.S. patent application serial number 09/523,460, attorney docket number 25791.11.02, which claimed the benefit of the filing date of U.S. provisional patent application serial number 60/124,042, filed on 3/11/1999, which was a continuation-in-part of U.S. patent application serial number 09/510,913, attorney docket number 25791.7.02, which claimed the benefit of the filing date of U.S. provisional patent application serial number

60/121,702, filed on 2/25/1999, which was a continuation-in-part of U.S. patent application serial number 09/502,350, attorney docket number 25791.8.02, filed on February 10, 2000, which claimed the benefit of the filing date of U.S. provisional patent application serial number 60/119,611, attorney docket number 25791.8, filed on 2/11/1999, which was a continuation-in-part of U.S. patent application serial number 09/454,139, attorney docket number 25791.3.02, filed on 12/3/1999, which claimed the benefit of the filing date of U.S. provisional patent application serial number 60/111,293, filed on 12/7/1998.

Accordingly, the latest possible priority date for the subject matter of the currently pending claims is July 29, 1999 – which is prior to the June 29, 2000 publication date of Simpson. Thus, Simpson is not prior art to any of the claims of the present application.

Thus, the rejection of claims 4-6, 93 and 94 in view of Simpson is improper.

#### **The Rejection Of Claim 7 in view of Nobileau**

Claim 7 was rejected under 35 U.S.C. 102(b) as being anticipated by Nobileau (US 5,794,702). The Applicant respectfully traverses.

It is noted that the rejection also refers to the Simpson reference. Thus, it is not at all clear what the basis for rejection is. To the extent that the Examiner is relying upon Simpson, as noted above, Simpson is not prior art to any of the claims of the present application. Thus, a rejection of claim 7 in view of Simpson is improper.

Assuming that the Examiner intended to rely solely upon Nobileau, Nobileau discloses a method for casing a wellbore in which a casing 15 is radially expanded and plastically deformed within a preexisting cased section 11. The cased section 11 is not radially expanded and plastically deformed (see, e.g., Fig. 14 – view of post-operation illustrating that casing 11 was not plastically deformed). Thus, the apparatus of Nobileau does not include an expansion mandrel including one or more surfaces for radially expanding and plastically deforming first and second tubulars.

Thus, contrary to the assertions of the Examiner, at least the following elements are not disclosed in Nobileau:

an expansion mandrel positioned within the first tubular member including one or

more outer surfaces for radially expanding and plastically deforming the first and second tubular members.

Consequently, the rejection of claim 7 in view of Nobileau is unsupported by the prior art and should be withdrawn. See MPEP § 2131.

**The Rejection of Claims 8-12, 14-20, 26, 27, 89-92 and 95-98 in view of Kinley:**

Claims 8-12, 14-20, 26, 27, 89-92 and 95-98 were rejected under 35 U.S.C. 102(b) as being anticipated by Kinley (US 3,191,677). The Applicant respectfully disagrees.

Kinley discloses a method and apparatus for setting liners in tubing that includes the use of multi-piece expander. One example of the Kinley expander includes three segments (29) of a truncated sphere that include diagonally curved end faces (30) that mate with one another (Figs. 4-7). Another example of the Kinley expander includes three segments (35) of a truncated sphere that include vertical end faces (36) and a surface groove (37) extending around the equator of the segments (Fig. 8). A final example of the Kinley expander includes three segments (38) of a body having a cylindrical portion and a conical end portion (Fig. 9).

Claim 8, as amended, recites: "An expansion cone for expanding a tubular member, comprising:

a one-piece housing including a tapered first end and a second end;  
one or more grooves defined solely in the outer surface of the tapered first end;  
and

one or more axial flow passages defined solely by the housing fluidically coupled to the circumferential grooves.

In the office action, at page 6, the Examiner asserts that the individual segments (35) of Fig. 8 of Kinley provide the one-piece housing of claim 8. However, a single segment (35) of Fig. 8 of Kinley does not include axial flow passages defined *solely* by the *single* segment (35) – as required by claim 8. Furthermore, it is noted that the segments (35) of Fig. 8 of Kinley are the only examples of segments within Kinley that define grooves *solely* in the outer surface of a *single* segment. Thus, this is the only

embodiment of a segment within Kinley that could even be *arguably* used as a basis for a rejection of any of claims 8-12, 14-20, 26, 27, and 95-98.

Thus, Kinley does not disclose or suggest the invention of claim 8. Furthermore, for at least the same reasons, Kinley also does not disclose or suggest the invention of claims 9-12, 14-20, 26, and 27, that depend from claim 8.

Furthermore, claim 10, which depends from claim 8, also requires “wherein the grooves comprise spiral grooves.” The groove (37) defined solely in the outer surfaces of the segments (35) of Kinley are not spiral grooves. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claim 10.

Furthermore, claims 12, 14, 15 and 16, which depend from claim 8, also require that “the axial flow passages comprise axial grooves.” The segments (35) of Kinley do not include axial grooves defined solely with the external surfaces of a segment. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claims 12, 14, 15, or 16.

Furthermore, claims 17-20, which depend from claim 8, also require that “the axial flow passages are positioned within the housing of the expansion cone.” The segments (35) of Kinley do not include axial flow passages positioned within the segment. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claims 17-20.

Furthermore, claim 26, which depends from claim 8, also requires that “... the angle of attack of the first tapered end of the body ranges from about 10 to 30 degrees.” The tapered ends of the segments (35) of Kinley do not include angles of attack that range from about 10 to 30 degrees – in fact, Kinley is completely silent on this point. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claim 26.

Furthermore, claim 27, which depends from claim 8, also requires that “... wherein the grooves comprise a plurality of grooves and are concentrated in a trailing edge portion of the tapered first end.” The segments (35) of Kinley include a single groove (37). Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claim 27.

Furthermore, claim 95, which depends from claim 8, also requires “an expansion

cone body comprising a plurality of adjacent discrete tapered sections." The segments (35) of Kinley include a spherical outer surface having a constant radius of curvature. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claim 95.

Furthermore, claim 96, which depends from claim 95, also requires "wherein the angle of attack of the adjacent discrete tapered sections increases in a continuous manner from one end of the expansion cone body to the opposite end of the expansion cone body." As discussed above, the segments (35) of Kinley include a spherical outer surface having a constant radius of curvature. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claim 96.

Furthermore, claim 97, which depends from claim 8, also requires "wherein the housing comprises: an paraboloid expansion cone body having a variable radius of curvature." As discussed above, the segments (35) of Kinley include a spherical outer surface having a constant radius of curvature. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claim 97.

Furthermore, claim 98, which depends from claim 97, also requires "wherein the angle of attack of the outer surface of the paraboloid expansion cone body increases in a continuous manner from one end of the paraboloid expansion cone body to the opposite end of the paraboloid expansion cone body." As discussed above, the segments (35) of Kinley include a spherical outer surface having a constant radius of curvature. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claim 98.

Claim 89 recites: An expansion cone for radially expanding a tubular member, comprising:

an expansion cone body comprising a plurality of adjacent discrete tapered sections;

wherein a plurality of the tapered sections radially expand the tubular member.

By contrast, the segments (35) of Kinley include a single hemispherical portion that radially expands the liner 17. Thus, Kinley does not disclose or suggest the invention of claim 89. Furthermore, for at least the same reasons, Kinley also does not disclose or suggest the invention of claim 90, that depends from claim 89.



Furthermore, claim 90, which depends from claim 89, also requires that “the angle of attack of the adjacent discrete tapered sections increases in a continuous manner from one end of the expansion cone body to the opposite end of the expansion cone body.” As discussed above, the segments (35) of Kinley expanders include a spherical outer surface having a constant radius of curvature. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claim 90.

Claim 91 recites: An expansion cone for radially expanding a tubular member, comprising:

an paraboloid expansion cone body having a variable radius of curvature.

By contrast, the segments (35) of Kinley expanders include a spherical outer surface having a constant radius of curvature. Thus, Kinley does not disclose or suggest the invention of claim 91. Furthermore, for at least the same reasons, Kinley also does not disclose or suggest the invention of claim 92, that depends from claim 91.

Furthermore, claim 92, which depends from claim 89, also requires that “the angle of attack of the outer surface of the paraboloid expansion cone body increases in a continuous manner from one end of the paraboloid expansion cone body to the opposite end of the paraboloid expansion cone body.” As discussed above, the segments (35) of Kinley expanders include a spherical outer surface having a constant radius of curvature. Thus, for these additional reasons, Kinley does not disclose or suggest the invention of claim 92.

#### **Claims 34-61 and 99-120:**

The Applicant notes with appreciation the indication of allowable subject matter for claims 34-61 and 99-120.

#### **Claims 13, 21-25, 28-33, 64, 66, 69-72, 75, 77, 80-82, 84, 87, and 88:**

Claims 13, 21-25, 28-33, 64, 66, 69-72, 75, 77, 80-82, 84, 87, and 88 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any

intervening claims. Accordingly, claims 13, 21-25, 28, 29, 31, 64, 66, 69-72, 75, 77, 80-82, 84, 87, and 88 have been amended to present their subject matter in independent form. Accordingly, the scope of claims 13, 21-25, 28, 29, 31, 64, 66, 69-72, 75, 77, 80-82, 84, 87, and 88 is unchanged, including the range of equivalents.

**Claims 121-131:**

Claims 111-131 present additional aspects of the invention that are not disclosed or suggested by the prior art of record.

Unless stated otherwise, none of the amendment to the claims were made for reasons substantially related to the statutory requirements for patentability.

Furthermore, unless stated otherwise, the amendment to the claims were made to simply make express what had been implicit in the claims as originally worded and therefore is not a narrowing amendment that would create any type of prosecution history estoppel. In addition, to the extent that the present amendment presents the subject matter of a dependent claim in independent form, such amendment does not in any way alter the scope of the claim, or equivalents thereof.

**Conclusion**

In view of the foregoing amendments and remarks, it is respectfully submitted that the pending claims are drawn to novel subject matter, patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and allow claims presented for reconsideration herein. To the extent that the present amendment results in additional fees, the Applicant authorizes the Commissioner to charge deposit account no. 08-1394.

S/N 10/030,593

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

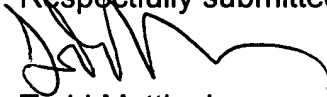
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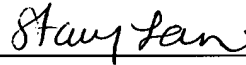
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